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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/766,298-Conf. #9344
	Filing Date	January 27, 2004
	First Named Inventor	David B. Spencer
	Art Unit	3654
	Examiner Name	T. H. Matthews
Total Number of Pages in This Submission	Attorney Docket Number	S1404.70004US01

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Transmittal of Amended Appeal Brief Copy of notification of non-compliant appeal brief Amended Appeal Brief Return Receipt Postcard
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Firm Name	WOLF, GREENFIELD & SACKS, P.C.		
Signature			
Printed name	Steven J. Henry		
Date	August 23, 2007	Reg. No.	27,900

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).		Complete if Known	
FEE TRANSMITTAL For FY 2007		Application Number	10/766,298-Conf. #9344
		Filing Date	January 27, 2004
		First Named Inventor	David B. Spencer
		Examiner Name	T. H. Matthews
		Art Unit	3654
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27	Attorney Docket No.	S1404.70004US01	
TOTAL AMOUNT OF PAYMENT	(\$)	0.00	

METHOD OF PAYMENT (check all that apply)	
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FEE CALCULATION							
1. BASIC FILING, SEARCH, AND EXAMINATION FEES							
	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
2. EXCESS CLAIM FEES							
						Small Entity	
Fee Description						Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
Total Claims		Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims		
_____ - 20 = _____		x _____	= _____		Fee (\$)	Fee Paid (\$)	
HP = highest number of total claims paid for, if greater than 20.							
Indep. Claims		Extra Claims	Fee (\$)	Fee Paid (\$)			
_____ - 3 = _____		x _____	= _____				
HP = highest number of independent claims paid for, if greater than 3.							
3. APPLICATION SIZE FEE							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
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Non-English Specification, \$130 fee (no small entity discount)						Fees Paid (\$)	
Other (e.g., late filing surcharge): _____							

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	27,900
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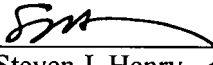
Docket No.: S1404.70004US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David B. Spencer et al.
Serial No.: 10/766,298
Confirmation No.: 9344
Filed: January 27, 2004
For: HIGH-SPEED MATERIALS SORTING SYSTEM
Examiner: T. H. Matthews
Technology Center: 3600

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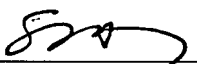
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Alexandria, VA 22313-1450

Dear Sir:

TRANSMITTAL OF AMENDED APPEAL BRIEF

In response to the Notification Of Non-Compliant Appeal Brief (copy enclosed), an amended Appeal Brief is provided herewith. Claims 22, 24 and 25 are now clearly mapped to the specification and drawings. A conforming amendment is also made to footnote 1.

Respectfully submitted,

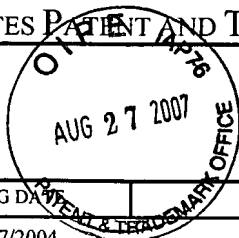

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Docket No.: S1404.70004US01
Date: August 23, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,298	01/27/2004	Edward J. Sommer JR.	S1404.70004US01	9344

7590 07/24/2007

Daniel P. McLoughlin
Wolf, Greenfield & Sacks, P.C.
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Boston, MA 02210

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/24/2007

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**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

10/766,298

Examiner

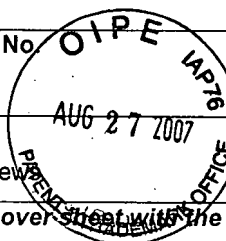
Terrell Matthew

Applicant(s)

SOMMER ET AL.

Art Unit

3654



--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 21 June 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

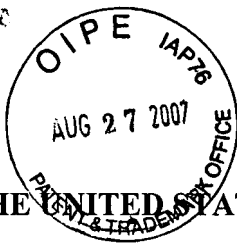
To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☐ Other (including any explanation in support of the above items):

4. Summary of Claimed Subject Matter: The independent claims 22, 24 and 25 should be mapped to the specification by page and line number, paragraph number, or to the drawings, if any.


Leneetha L. Dyar
Patent Appeal Center Specialist



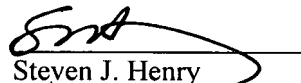
Docket No.: S1404.70004US01

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Applicant: David B. Spencer et al.
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Examiner: T. H. Matthews
Technology Center: 3600

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 23rd day of August, 2007.


Steven J. Henry
Reg. No. 27,900

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P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPELLANT'S AMENDED BRIEF PURSUANT TO 37 CFR §41.37

This brief is submitted in furtherance of the Notice of Appeal filed on November 16, 2006, in the above-referenced application.

The required extension fee was previously paid. No further fee is due. If any additional fee is required for consideration of this paper, the Director is authorized to charge such fee to the deposit account identified on the Transmittal filed herewith.

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I. REAL PARTY IN INTEREST (37 CFR §41.37(c)(1)(i))

The real party in interest for this appeal is the Assignee, Spectramet LLC, a Delaware limited liability company having a place of business at Corporation Trust Center, 1209 Orange Street, Wilmington, Delaware, 19801.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS (37 CFR §41.37(c)(1)(ii))

There are no other appeals, interferences, or judicial proceedings which will directly affect, or be directly affected by, this appeal.

III. STATUS OF CLAIMS (37 CFR §41.37(c)(1)(iii))

Following entry of the Amendment Under 37 CFR §1.116 filed herewith, there are/will be six claims pending in this application when the Board receives this appeal, claims 13, 22-25, and 46.

The status of each of the claims is summarized below:

1. Canceled: claims 1-12, 14-21, 26-45 and 47-61. (Claims 1-9, 14-21, 26-45 and 47-61 are canceled in the Amendment Under 37 CFR §1.116).
2. Withdrawn from consideration: none.
3. Pending: claims 13, 22-25 and 46.
4. Allowed: none.
5. Rejected and appealed: claims 13, 22-25 and 46.

A copy of the pending claims involved in the present appeal is attached hereto as Appendix A.

IV. STATUS OF AMENDMENTS (37 CFR §41.37(c)(1)(iv))

An amendment under 37 CFR §1.116 is being filed concurrently herewith to cancel without prejudice claims 1-9, 14-21, 26-45 and 47-61 and to rewrite claims 13 and 46 in independent form. As such amendment only cancels claims and rewrites claims 13 and 46 into independent form, it is therefore filed as a matter of right under 37 CFR §1.116, so it shall be assumed that the claims amended and canceled in the amendment have, in fact, been amended and canceled from the application.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 CFR §41.37(c)(1)(v))

In its various aspects, the claimed (and appealed) subject matter involves generally systems and methods for sorting materials through the use of multiple types of characteristic emissions from the material, and to computer-readable media containing instructions for implementing those methods. The emissions are typically x-ray fluorescence (XRF) emissions in response to x-ray stimulation and optical emissions in response to laser irradiation or electrical discharge used to vaporize some of the material. (Page 7, lines 27-32; Fig. 2; Page 16, line 21 - page 20, line 14.)

Without in any way intending to characterize or mischaracterize the claimed subject matter, as the claims speak for themselves, and oversimplifying to aid the Board in its initial understanding, claims 13 and 46 define methods, claims 22 -24 define apparatus, and claim 25 defines articles of manufacture which share the characteristic that material classification is performed in two stages, each considering separately and individually one of the two types of emissions, using one type of emissions to achieve a pool of potential material classifications and then refining the identification/classification from among the candidates determined by initial classifications through the analysis of the second of the types of emissions.

Independent claims 22 and 24 are drawn to a system for classifying material and will be discussed first. In claim 22, the system comprises a classification module (Fig. 2: 216; Page 18, lines 20-22) which (a) receives x-ray fluorescence information representing x-rays fluoresced from the material (and detected by a detector such as 210 or 610 - e.g., Page 17, line 3 - Page 18,

line 19; Fig. 9 and Page 35, lines 3-22 and element 918), (b) receives optical emissions information representing optical emissions emitted from the material (and detected by a detector such as 212 or 612 - e.g., Page 17, line 3 - page 18, line 19; Fig 9; Page 35, lines 3-22) and (c) classifies the material based on at least one of the x-ray fluorescence (XRF) information and the optical emissions information - Page 19, line 4 - page 20, 14; Fig. 9; Page 35, lines 3-6, element 930. The classifying operation includes reducing the number of potential classifications by analyzing “*only* a first one of [the] two types of emissions”, and selecting one of the reduced number of classifications “by analyzing *only* a second one of the types of emissions” (See, e.g., claim 13¹; emphasis added. Page 25, line 16 - page 27, line 21; Page 36, lines 15-31; original claims 13 and 19). A slightly different expression is used in claim 24, wherein the system is defined as one in which a number of potential classifications are available, and the system includes inputs to receive x-ray fluorescence information and optical emissions information (e.g., 210, 610, 212, 612; See also page 27, lines 18-21 et seq.); and means (216, 930) for classifying the material based on that emissions information including means for reducing the number of potential classifications “by analyzing *only* a first one of [the] two types of emissions” (page 36, lines 29-31) and means for selecting one of the reduced number of classifications “by analyzing *only* a second one of the two types of emissions that was not analyzed in reducing the number of potential classifications.” (Emphasis added; original claims 13 and 19.)

Similarly, independent claim 25 is drawn to a computer-readable medium ((Figs. 13; 1301) having computer-readable signals stored thereon that define instructions that, as a result of being executed by a computer, control the computer to perform a particular method of classifying material, wherein a number of potential classifications are available. The method comprises acts as specified in claim 22, referenced above: (A) detecting x-rays fluoresced from the material; (B) detecting optical emissions emitted from a plasma resulting from a vaporization of a portion of the material; and (C) classifying the material based on the detected x-rays and the detected optical emissions by (1) reducing the number of potential classifications “by analyzing *only* a first one” of the two types of emissions and (2) selecting one of the reduced number of classifications by analyzing “*only* a second one of the two types of emissions” that was not

¹ Upon remand, the body of the specification will be amended to include the express language recited in claims 13 and 19 as an original part of the specification.

previously analyzed. (original claim 13; emphasis added.)

Claims 13 and 46 define methods with limitations similar to those of claims 22-24 and Applicant is satisfied to have them considered on the basis of the remarks made relative to claims 22-24 as it is believed these claims present the same issues for patentability consideration.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 CFR §41.37(c)(1)(vi))

Review is sought of the rejection of claims 13, 22-25 and 46 under 35 USC 103(a) as unpatentable over Grodzins (US-6801595) in view of Graft.

VII. ARGUMENT (37 CFR §41.37(c)(1)(vii))

A. The obviousness rejection of every pending claim should be reversed, as the rejections are unsupported and in violation of Federal Circuit case law and the MPEP.

As set forth in MPEP § 2143, three criteria must be met in order to establish a *prima facie* case of obviousness. First, there must be some specific suggestion or motivation, either in the cited reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s). Second, there must be a reasonable expectation of success. The specific teaching or suggestion to modify the reference(s), as well as the reasonable expectation of success, must both be found in the prior art and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Third, the reference(s) must teach or suggest all of the claimed features.

MPEP § 2142 makes clear that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, Applicants are under no obligation to submit evidence of non-obviousness.

In the present application, the Examiner has significantly failed to meet his burden of establishing a *prima facie* case of obviousness.

First, the cited Grodzins and Graft references, alone or in combination, fail to teach or suggest one or more features of each of Applicants' independent claims; that is, at least one element of each independent claim is entirely missing from both of the cited references. Specifically, both the references fail to teach or suggest any feature relating to "analyzing *only* a first one of [the] two types of emissions", and selecting one of the reduced number of classifications "by analyzing *only* a second one of the types of emissions" to use the language of claim 22 (the other claims incorporating substantially similar language). The contrary method and apparatus of each reference are discussed below, demonstrating not only how these limitations are absent, but also how they are inconsistent with each of the references.

For this reason alone, the Final Office Action fails to establish a *prima facie* case of obviousness and, therefore, the combination of Grodzins and Graft is improper.

Second, the Examiner has completely failed to point to any acceptable motivation or suggestion in the prior art *to modify* the teachings of Grodzins with the teachings of Graft to achieve the claimed invention. It is well-established that, to support an obviousness rejection, the Examiner must specifically identify a reasoned motivation to change the prior art or combine prior art teachings so as to result in something that falls within the scope of the claims. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) (reversing rejection because specific motivation in the prior art not identified). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). If the Examiner fails to clearly and particularly identify in the prior art, or in the knowledge of those skilled in the art, or even in common sense, any suggestion, teaching, or motivation to modify a reference, the rejection cannot be maintained. See *Dembiczak*, 175 F.3d 994 (emphasis added). The recent Supreme Court decision in *KSR* is not to the contrary. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007), 2007 WL 1237837. Valid reasons are still required to be provided.

With respect to such suggestion or motivation, in the present case the Examiner fails to specify any reasonable or compelling motivation to combine the teachings of the references *in a manner that will result in the claimed invention*. Instead, the Examiner merely states on page 6 of the Final Office Action that:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the apparatus of Grodzin (sic) to include the teachings of Graft so that you could screen more precisely for elements having certain characteristics.

Thirdly, as discussed in greater detail below, the alleged motivation provided by the Examiner for modifying Grodzins with the teachings of Graft is not only difficult to understand objectively, but also, moreover, legally unacceptable. What teachings of Graft are to be incorporated into Grodzins? How? Neither Applicants nor the Board should have to guess, but that is precisely the situation the Examiner has created. A motivation to combine must contain a notion of *how* to effect the combination – or it must be apparent. Otherwise, there is no reason to expect success.

The Final Office Action fails to point to any evidence, either in the references themselves or in the knowledge generally available in the art, of a reasonable expectation of success in combining the references in such a way as to achieve the claimed invention. Most notably, the Final Office Action completely fails to specify or suggest in any manner how one of ordinary skill in the art would practically and realistically combine various elements of the two references to successfully arrive at something that would even remotely resemble the subject matter of Applicants' claims.

Thus, the Examiner has failed to meet his burden with respect to each of the three elements required to establish a prima facie case of obviousness. Failure to meet any one of these elements – a teaching or suggestion of all claim elements, a specific suggestion or motivation to modify the prior art, and a reasonable expectation of success – is sufficient to render such a rejection improper. In the present case, the Examiner's basis for rejection is deficient with respect to all three elements. Accordingly, the rejections must be reversed.

Following below are summaries of the Grodzins and Graft references, as well as a more detailed discussion of the impropriety of the Examiner's rejections based on a combination of these references.

B. Discussion of the Grodzins Reference

Grodzins discloses an apparatus in which a material is irradiated by both x-rays and by a laser – apparently concurrently, to generate an x-ray fluorescence signature and an optical

emissions signature. BOTH the x-ray data and the optical signal data are used to identify the material. (Abstract: “[A] processor is included that analyzes and combines the x-ray signal output and the optical signal output to determine the composition of the test material.” See also col. 2, lines 48-50; col. 3, lines 5-8; Fig. 1.) In fact, the two emissions are used in a very specific way, one which differs significantly from that of the claimed invention. As Grodzins states, “[t]he data that is contained within the optical signal output is *relative* data concerning the concentrations of elements in the test sample, while the data that is contained within the x-ray signal output is *absolute*.” Col. 2, lines 64-67; emphasis added. Accordingly, Grodzins’ processor 8 “uses data from the optical signal output and the x-ray signal output about [a] common element *to normalize data contained within the optical signal output*.” Col. 3, lines 6-8; emphasis added. The end determination of the test material’s composition is made from the calibrated optical signal alone.

At no time does Grodzins ever reduce the number of potential classifications of a subject material by analyzing “*only* a first one of [the] two types of emissions” – x-ray or optical - and select one of the reduced number of classifications “by analyzing *only* a second one of the types of emissions”. Neither does Grodzins ever suggest such an approach. But, of course, the rejection was made under Section 103, not under Section 102. So we must ask whether Graft might suggest a modification of Grodzins along the lines of the claimed invention. The answer, clearly, is negative.

C. Discussion of the Graft Reference

Graft shows a system and method that uses only optical emissions (provided by laser-induced breakdown spectroscopy) to analyze a material. That is, there is no x-ray fluorescence generated in the Graft system or method. Graft teaches that intensity *ratios* of optical emission lines (and only optical emission lines) may be calculated and used as signatures to be matched to a database to identify the presence or absence of specific ions or elements or trace metal compounds in a material sample. Graft, Abstract; col. 2, lines 59-61; col. 3, lines 5-42.

D. Grodzins and Graft Fail to Teach or Suggest All Elements of Applicants' Independent Claims

1. Claim 22.

Claims 13, 22-25 and 46 stand rejected under 35 USC 103(a) as obvious over Grodzins in view of Graft. The rejection should be reversed because the result of combining the references, even if such a combination were proper as proposed in the Office Action, would not be the claimed invention.²

Claim 22 is drawn to a system for classifying material. The system comprises a classification module to (a) receive x-ray fluorescence information representing x-rays fluoresced from the material, (b) receive optical emissions information representing optical emissions emitted from the material and (c) classify the material based on at least one of the x-ray fluorescence (XRF) information and the optical emissions information. The classifying operation includes reducing the number of potential classifications by analyzing “*only* a first one of [the] two types of emissions”, and selecting one of the reduced number of classifications “by analyzing *only* a second one of the types of emissions”. (Emphasis added.)

In rejecting this claim, the Office Action is somewhat unclear as to *how* the references are to be applied. The Office Action does not point to any portion of either reference for the disclosure of such a classification module. It is incumbent on the Examiner, however, to define how the references are to be applied, limitation by limitation, to justify a rejection. *Ex parte* Kalliokulju, 2007 WL 1378833 (BPAI May 10, 2007) (No. 2007-0834, Tech. Ctr. 2100). As stated in that opinion at 3-4:

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “there must be

² Applicants do not concede the propriety of the combination, but this is a matter that will be addressed separately, below.

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. ____, 2007 WL 1237837, at *14 (quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Here, on page 5 of the Office Action, the Examiner has indicated that “Grodzin (sic) discloses the invention as described above in detail” relative to other claims – method claims – but he does not articulate what aspect(s) of the invention defined in claim 22 is(are) disclosed in Grodzins or where it(they) is(are) disclosed, leaving Applicants to guess. This is improper and requires reversal of the rejection.

The Office Action goes on to say that “Grodzin (sic) does not disclose” various features not recited in claim 22 (apparently leaving Applicants and the Board to assume the Examiner believes, without citation, that the other elements and limitations of claim 22 are to be found somewhere in Grodzin) and then perfunctorily states, again without specific citation, “Graft further discloses the invention as described above.” Yet the above-quoted limitations of claim 22 were not present in any claim previously discussed in the Office Action so it is not seen how any “above” discussion of Graft would justify the rejection of claim 22.

Moreover, if a limitation is not found in Grodzins, the Examiner must explain how Graft would supply that limitation, with specific reference to the text and drawings of Graft. Broad, sweeping conclusions do not constitute a basis for a *prima facie* proper rejection. Such reasoning, resting on a lack of detailed citations, amounts to conclusory guesswork.

Indeed, no amount of modification of the apparatus of Grodzins based on the teachings of Graft will lead to the invention of claim 22 even if the hypothesized motivation is accepted as valid (which it is not). The features of claim 22 missing in Grodzins (see above) are also missing in Graft.

In short, the subject matter of claim 22 is in no way rendered obvious, even with the benefit of hindsight, from a combination of Grodzins and Graft, regardless of how one combines those references.

2. Claims 13, 23-25 and 46.

Claims 13, 23-25 and 46, though differing in various respects from claim 22 and from each other, share a common thread, the use of x-ray fluoresced emissions and optical emissions in the manner discussed above, so that the use of information obtained from one type of emissions informs the analysis performed using the other of the types of emissions. Consequently, neither do Grodzins and Graft, alone or in combination, establish that the inventions of any of claims 13, 23-25 and 46 should have been obvious to one skilled in the art when Applicants filed their parent application.

E. There is No Motivation to Combine Grodzins and Graft, and No Reasonable Expectation of Success

Without having explained how either Grodzins or Graft applies to teach the aspects of claim 22 quoted above, the Office Action concludes it would have been obvious to modify the apparatus of Grodzins to include the teachings of Graft, reciting a hypothetical motivation to “screen more precisely for elements having certain characteristics.” How such a hypothesized motivation would result in an improvement of Grodzins to “more precisely” screen for elements is entirely unclear. Grodzins employs both XRF and optical emission. Graft employs only optical emission. How would Graft, then, result in more precise screening, and how would it suggest modifying Grodzins? Applicants suggest this is a figment of the Examiner’s imagination and that, even if such a result is possible, the Examiner has given no roadmap to achieving it.

Moreover, it will now be clear that nothing in Graft, Grodzins or the knowledge of one ordinarily skilled in the art would have suggested their combination or, more importantly, that they could be combined to form the claimed invention, since they, in fact, cannot be combined in any way that results in the claimed invention while remaining true to their individual objectives.

There is no teaching in Graft that could have been used to motivate a modification of Grodzins to achieve the invention of claim 22. That is, nothing in Graft would have suggested turning Grodzins into a two-step operation using a first kind of emission by itself to create a candidate set of possibilities and a second, different type of emission by itself to refine the analysis of the material – rather than using XRF to calibrate relative values of optical emissions. Were Graft used to modify Grodzins, the logical combination of those systems and methods

would have been to employ the specific ratio technique of Graft in the Grodzins processing of optical emissions data. However, note that since Graft uses *ratios* of optical emissions, it does not require absolute values to get results. The signals being compared, as they are produced by the same laser intensity, will scale together. Hence, the Examiner is not suggesting a mere modification of Grodzins, but a whole new system that basically reduces to being Graft alone since the x-ray part of Grodzins becomes superfluous. There would be no motivation to use the more complicated normalization technique of Grodzins on the data produced in Graft. To do so involves complexity and inefficiency without, it would seem, any material improvement in results. Hence, it would be illogical to make such a combination and even if the combination were made, the result would either be a Graft-like system to which normalization is applied to the optical signals so that the ratios are formed of normalized values (presumably being the same or substantially the same ratios as are obtained from the non-normalized signals) or a Grodzins-like system in which the optical processing would be of multiple optical signals, to form ratios. Either way, the result is not the claimed invention or anything that works in a similar way. The only similarity would be that materials identification is being performed through the use of both x-ray and laser-induced stimulation of emissions from the material under examination. But Applicants do not claim to have invented –broadly speaking – the use of both sources of radiation. Rather, Applicants claim a specific approach to a method, apparatus and product that, in an unobvious way, uses both kinds of stimuli evaluated in succession to achieve a materials analysis that is accurate and can be performed at high speeds.

To be sure, Graft (like Grodzins) does mention the use of x-ray excitation of a material in addition to optical excitation. Nothing new here. But Graft does not do so in the manner claimed or for the reason behind the claims. Rather, Graft mentions that he used x-ray diffraction to identify certain samples of ore as comprising samples having the mineral apatite or samples having the mineral dolomite. Col 7, lines 20-25 et seq. Graft was looking for a way to employ optical spectra, apparently, *instead* of x-ray diffraction spectra, to identify minerals in ore samples and he engaged in experiments to cross-check his results, seeking specific effective laser frequencies and optical emissions ratios to define signatures usable for identifying specific minerals. Thus, Graft found “[t]he significant difference between apatite and dolomite is the presence of a peak near 483 nm in the apatite spectrum that is not present in the dolomite

spectrum.” Col. 9, lines 18-20. So, if looking for apatite and wanting to assure that the results were representative of apatite and not dolomite, one would investigate 483 nm and compare the results with the signal at some other wavelength. Once Graft had established that it was possible to correlate results of x-ray diffraction with results of optical emissions, therefore, he no longer had need for x-ray diffraction and, indeed, his invention does not employ x-ray diffraction at all.

Graft acknowledged the use of gamma-ray and x-ray fluorescence techniques for “accept/reject” mineral identification in samples on moving belts (Col. 1, lines 22-35), but he then goes on to explain how laser-induced breakdown spectroscopy (LIBS) has been shown to be practical in situations which require very fast, real-time measurements with no sample preparation. Col. 2, lines 40-42. The apparent message is that x-ray fluorescence and the like are not fast enough for his purposes. Indeed, that is one of the serious challenges in the use of XRF that Applicants have spent a great deal of time and money addressing, going against such teachings to find ways that high-speed XRF can be made possible. One of ordinary skill in the art, therefore, would read Graft as teaching *away* from the use of x-ray diffraction as a tool for use in a high-speed materials identification system. Hence, one would not have gleaned from Graft any notion of effecting a combination with Grodzins. By painting with a broad brush, the Examiner fails to perceive the importance of the claimed limitations or the failure of Graft to suggest a modification of Grodzins meeting the claim language.

For like reasons, the references also fail to suggest a combination meeting the limitations of claims 13, 23-25 and 46.

VIII. CONCLUSION


In sum, the Examiner has failed to meet his burden with respect to each of the three elements required to establish a *prima facie* case of obviousness. Failure to meet any one of these elements – a teaching or suggestion of all claim elements, a legally adequate, specific suggestion or motivation to modify the prior art, and a reasonable expectation of success – is

sufficient to render such a rejection improper. In the present case, the Examiner's basis for rejection is deficient with respect to all three elements.

Accordingly, the rejection of the claims is improper and should be reversed.

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Respectfully submitted,

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APPENDIX A**Claims Involved in the Appeal of Application Serial No. 10/766/298**

1-12. (Cancelled)

13. (Previously presented) A method of classifying material, wherein a number of potential classifications are available, the method comprising acts of:

- (A) detecting x-rays fluoresced from the material;
- (B) detecting optical emissions emitted from a plasma resulting from a vaporization of a portion of the material; and
- (C) classifying the material based on the detected x-rays and the detected optical emissions, including acts of
 - (1) reducing the number of potential classifications by analyzing only a first one of two types of emissions: the detected x-rays or the detected optical emissions; and
 - (2) selecting one of the reduced number of classifications by analyzing only a second one of the two types of emissions that was not analyzed in the act (C)(1);

wherein

- the act (C)(1) includes analyzing only the detected optical emissions and
- the act (C)(2) includes analyzing only the detected x-rays.

14 - 21. (Canceled)

22. (Previously presented)) A system for classifying material, comprising:

a classification module to receive x-ray fluorescence information representing x-rays fluoresced from the material, to receive optical emissions information representing optical emissions emitted from the material, and to classify the material based on at least one of the x-ray fluorescence information and the optical emissions information, the classifying including reducing the number of potential classifications by analyzing only a first one of two types of

emissions: the detected x-rays or the detected optical emissions; and selecting one of the reduced number of classifications by analyzing only a second one of the two types of emissions that was not analyzed in reducing the number of potential classifications.

23. (Previously presented) The system of claim 22, further comprising:

an x-ray detector to detect the x-rays fluoresced from the material;

an optical emissions collector to detect the optical emissions emitted from the material.

24. (Previously presented) A system for classifying a piece of material, wherein a number of potential classifications are available, comprising:

one or more inputs to receive x-ray fluorescence information representing x-rays fluoresced from the material and optical emissions information representing optical emissions emitted from the material; and

means for classifying the material based on the x-ray fluorescence information and the optical emissions information including means for reducing the number of potential classifications by analyzing only a first one of two types of emissions: the detected x-rays or the detected optical emissions and means for selecting one of the reduced number of classifications by analyzing only a second one of the two types of emissions that was not analyzed in reducing the number of potential classifications.

25. (Previously presented) A computer-readable medium having computer-readable signals stored thereon that define instructions that, as a result of being executed by a computer, control the computer to perform a method of classifying material, wherein a number of potential classifications are available, the method comprising acts of:

(A) detecting x-rays fluoresced from the material;

(B) detecting optical emissions emitted from a plasma resulting from a vaporization of a portion of the material; and

(C) classifying the material based on the detected x-rays and the detected optical emissions, including acts of

- (1) reducing the number of potential classifications by analyzing only a first one of two types of emissions: the detected x-rays or the detected optical emissions; and
- (2) selecting one of the reduced number of classifications by analyzing only a second one of the two types of emissions that was not analyzed in the act (C)(1).

26 -45. (Canceled)Previously presented)

46. (Previously presented)) A method of classifying material, the method comprising acts of:

- (A) applying an electrical discharge to vaporize a portion of the material to produce a plasma;
- (B) detecting optical emissions emitted from the plasma;
- (C) detecting x-rays fluoresced from the material; and
- (D) classifying the material based on the detected x-rays and/or the detected optical emissions;

wherein the act (D) comprises:

- (1) reducing the number of potential classifications by analyzing only a first one of two types of emissions: the detected x-rays or the desired detected optical emissions; and
- (2) selecting one of the reduced number of classifications by analyzing only a second one of the two types of emission that was not analyzed in the act (D)(1).

47-61. (Canceled)

APPENDIX B

EVIDENCE (37 CFR §41.37(c)(1)(ix))

No evidence pursuant to §§1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

RELATED PROCEEDINGS (37 CFR §41.37(c)(1)(x))

No related proceedings are referenced in Section II. above. Hence, no copies of decisions in related proceedings are provided.